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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/926,872 09/10/97 SULLIVAN

M SLD2121

024492 QM22/0323
SPALDING SPORTS WORLDWIDE INC
425 MEADOW STREET
PO BOX 901
CHICOPEE MA 01021-0901

EXAMINER

GORDON, R

ART UNIT

PAPER NUMBER

3711

DATE MAILED:

03/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 27

Application Number: 08/926,872

Filing Date: 09/10/97

Appellant(s): Sullivan et al.

MAILED

MAR 22 2001

GROUP 3700

Richard M. Klein
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 1/19/01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit: 3711

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1 and 3-8 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

Art Unit: 3711

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 3-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 contains subject matter not present in the original disclosure: 1) specific gravity of the core less than 1.4, 2) specific gravity of the intermediate layer less than 1.2, 3) JIS-C hardness of the intermediate layer from 85 to 89.9.

(11) *Response to Argument*

Appellant's overall argument is the specification must reasonably convey to one skilled in the art that the inventor had possession of the claimed subject matter rather than the presence or absence of literal support. The Examiner agrees. However, that one skilled in the art might realize from reading the specification that appellant's proposed interpretation may be one possibility among others is not a sufficient indication to that person that such a possibility satisfies the test for compliance with the description requirement. See *In re Barker*, 194 USPQ 470.

Appellant's first argument in claim 1 is that the core has a specific gravity less than 1.4. As support Appellant discloses a specific gravity of 1.47 and 1.17, one of which is over the 1.4 limitation. The Examiner agrees the disclosed value 1.17 is less than 1.4 but the remaining values in the range are not disclosed nor is the range mentioned in the specification.

Art Unit: 3711

The limitation requires the specific gravity to be less than 1.4 or from 0 to 1.4. Disclosing a value (1.17) between the range of 0 to 1.4 does not reasonably convey to the artisan that other values may be included in the invention.

The second argument regarding the specific gravity of the intermediate layer is also not in the specification. The claim requires the intermediate layer to be less than 1.2 but the specification does not disclose the range. Appellant gives values of 1.3, 0.95, 0.953, and 0.960 as support for the specific gravity being less than 1.2. Obviously 1.3 is outside the range in question. The values 0.953 and 0.960 cited on page 24 of the specification are specific gravity values for the base ionomer and not the actual composition of the intermediate layer. Therefore the only value relevant to the intermediate layer having a specific gravity less than 1.2 is the value 0.95. However as previously mentioned, the value does not reasonably convey to the artisan that the remaining values between 0 and 1.2 are included in the invention.

Appellant's third argument is the intermediate layer having a JIS-C hardness from 85 to 89.9. Appellant discloses a Shore D hardness of at least 60, which converts to approximately 90 on the JIS-C scale. Please see the attached Correlation scale between JIS-C and Shore D.

Appellant's fourth argument in claim 6 is the difference of 0.1 to 0.5 between the core and the intermediate layer specific gravity. Again values with the claimed range have been shown but the entire range is not disclosed.

Art Unit: 3711

Appellant's remaining arguments regarding 35 U.S.C 112, 1st paragraph and 35 U.S.C 101 rejections have been overcome by the amendment after the final rejection. The provisional obviousness double patenting rejection over applications 08/926,194 and 09/926,246 have been overcome by the terminal disclaimer filed 12-28-00.

For the above reasons, it is believed that the rejections should be sustained.

Appeal Confessor
MT
M. Graham

S. Wong
h

Respectfully submitted,

Raeann Gorden

rg
March 20, 2001

Mark S. Graham
Mark S. Graham
Primary Examiner



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